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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,613	10/26/2000	Harold A. Chapman	18989-006 (BWH-6)	4800

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BOSTON, MA 02111

EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 05/01/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/697,613

Applicant(s)

CHAPMAN ET AL.

Examiner

Dr. Kailash C. Srivastava

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 1, 2003 as Paper Number 11.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9-14,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 9-14 and 22-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicants' amendment filed April 1, 2003 as Paper Number 11 in response to Office Action mailed October 1, 2002 as paper number 8 is acknowledged and entered.
2. Claims 5-8 have been cancelled.
3. Claims 22 -23 have been added.
4. Claims 1, 9-14 and 22-23 are pending.
5. Further review in this application shows that a restriction is required as outlined below.

Election/Restriction

6. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I – Claims 1, 9-12 and 23 drawn to a method to treat atherosclerosis by administering a composition comprising cystatin C, classified under Class 424, Subclass 94, for example.

Group II – Claims 13-14 drawn to a method to treat atherosclerosis by administering a composition comprising transforming growth factor beta 1, classified under Class 514, Subclass 21, for example.

Group III – Claim 22 drawn to a method to treat atherosclerosis by administering a composition comprising a polypeptide of SEQ ID NO: 3, classified under Class 530, Subclass 300, for example.

7. The methods in Groups I-III are unrelated to each other because they are directed to inventions that are not connected in design, operation and/or effect. These inventions are independent since they are not disclosed as capable of use together. The inventions have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various inventions at the same time to practice just one invention alone (MPEP § 806.04, MPEP § 808.01). In the instant case, inventions recited in Groups I-III are different from each other because each one of these inventions requires different components and are drawn to a different material. Furthermore, inventions in any one of the groups I-III will not be administered together with the other.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each one of the above inventions is not coextensive particularly with regard to the literature search. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (class/subclass) and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.


8. In response to the rejections to Claims 1 and 5-14 in the Office Action mailed October 1, 2002 as paper number 8, applicants argue that the claimed invention is neither anticipated, nor is obvious over examiner-cited prior art references.

Applicants' arguments cited *supra*, with respect to claims 1 and 5-14 have been considered but are moot in view of the restriction requirement necessitated because of applicants' amendment cited *supra*.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (703) 605-1196. The examiner can normally be reached on Monday to Thursday from 7:30 AM to 6:00 P.M (Eastern Daylight Saving, or Standard time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Kailash C. Srivastava, Ph.D.
Patent Examiner
Art Unit 1651

April 29, 2003



CHRISTOPHER R. TATE
PRIMARY EXAMINER